

## Remarks

### Status of the Claims

This paper is filed in response to the Office Action mailed March 25, 2008, in which claims 1-37 were pending in the application. All pending claims stand rejected. By this paper, claim 1 has been amended. For the reasons set forth below, Applicants submit that each of the pending claims is patentably distinct from the cited prior art and in condition for immediate allowance. Reconsideration of the claims is therefore respectfully requested.

### Claim Rejections

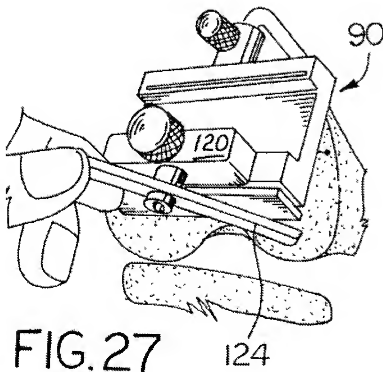
Claims 1-37 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,830,216 issued to Insall et al. ("Insall") in view of U.S. Patent No. 5,423,827 issued to Mumme et al. ("Mumme"). However, as discussed below, the cited prior art references—whether considered individually or collectively—fail to disclose or suggest each of the limitations in any of the pending claims.

#### Insall

The Examiner cites to Figure 27 of Insall and suggests that posterior resection gauge 120 might satisfy the limitations associated with Applicants' claimed "first member" and that Insall's cutting guide 90 might satisfy the limitations associated with Applicants' claimed "cut guide member." Although it is not entirely clear which element of Insall is alleged to satisfy the limitations associated with Applicants'

claimed “second member,” it appears that the Examiner is asserting that boom 112 does so. The elements disclosed in Insall, however, cannot satisfy each of the limitations of independent claim 1, regardless of which elements of the Insall disclosure are considered.

Figure 27 is reproduced below for the Examiner’s reference.



As shown in this figure, posterior resection gauge 120 is attached to cutting guide 90. Claim 1 calls for “a cut guide member releasably secured directly to the second member . . . ***such that the cut guide member and the second member move together about the pivot of the first member.***” No combination of the Insall components meets these limitations. To illustrate, cutting guide 90 is not configured to rotate about any axis at all, let alone the axis of the pivot of Applicants’ claimed first member. In fact, posterior resection gauge 120 is rigidly fixed with respect to

cutting guide 90. See FIGS. 11 and 14; column 7, lines 7-11 ("Alignment pins 130 engage the alignment holes 106 and the attachment screw 128 threads into the threaded attachment hole 104. With the attachment screw tightened, the Posterior Resection Guide 120 is rigidly fixed to the A/P Cutting Guide 90."). There is no pivot point between the two components.

Posterior resection gauge 120 does include a pivot 126. However, only wing 124 moves about pivot 126. There are no two components which move about this pivot, let alone a cut guide member releasably secured to a second member, as is called for by claim 1.

The Examiner also refers to the reference markers shown in Figure 28 and asserts that this proves that the device is "capable of rotational movement." Office Action at page 2. Figure 28 is reproduced below.

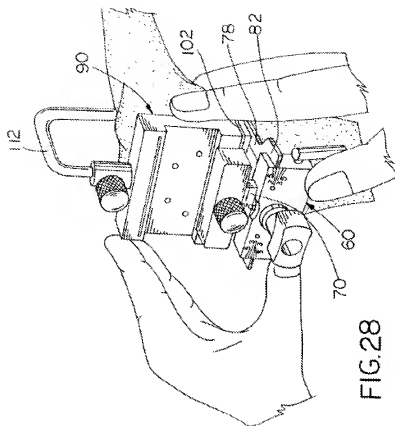


FIG. 28

Applicants do not dispute that the Insall device contains a component which is capable of rotational movement. The Examiner is quite right that a portion of posterior reference/rotation guide 60 is capable of rotational movement. However, claim 1 requires more than just a component that is capable of rotational movement. Again, claim 1 requires a first member having a pivot, along with a cut guide member releasably secured directly to a second member ***such that the cut guide member and the second member move together about the pivot of the first member.*** The only rotational movement associated with posterior reference/rotation guide 60 occurs between feet 78 and sliding member 72, both of which are components of the posterior reference/rotation guide 60. See, e.g., column 6, lines 3-6 ("A rotation lock

86 locks the pivot 80. When the rotation lock 86 is activated by rotating it clockwise, the feet 78 are prevented from rotating relative to the sliding member 72.”).

There is no rotational movement about a common pivot point between posterior reference/rotation guide 60—or any component thereof—and cutting guide 90. Indeed, the feature of allowing feet 78 to rotate is merely to allow for a second layer of verification of the amount of external rotation of the knee. *See, e.g.*, column 8, lines 5-15 (“The amount of external rotation relative to the posterior condyles can be checked at this point as an additional verification of proper external rotation (FIG. 21). To do this the Posterior Reference/Rotation Guide 60 is attached to the Epicondylar Guide 40 and the feet are brought into contact with the posterior condyles 148. The amount of rotation relative to the posterior condyles is then read from the external rotation scale 84. If a valgus knee measures greater than 8 degrees of rotation, or a varus knee greater than 5 degrees, the Epicondylar Guide 40 should be reset within that range.”). To further illustrate, Insall is clear that the angle measured by external rotation scale 84 is between feet 78 and cutting slots 100 and 102 (both located on cutting guide 90). Column 6, lines 63-65 (“The external rotation scale 84 and lateral extensions 82 indicate the angle of the feet 78 relative to the cutting slots 100 and 102 and the fin 110.”). If there were common rotation between feet 78 and cutting guide 90, external rotation scale 84 could not be used for this purpose.

### Mumme

It appears to Applicants that Mumme was cited solely for its applicability to one or more of the pending *dependent* claims in the Application, since the language used by the Examiner in citing Mumme does not correspond with the language used in independent claim 1. However, since the Examiner has not addressed each claim separately, this is not entirely clear. Thus, for the sake of completeness, Applicants will address Mumme below as though it is being used in rejecting independent claim 1.

Like Insall, Mumme fails to disclose or suggest providing “a cut guide member releasably secured directly to the second member . . . ***such that the cut guide member and the second member move together about the pivot of the first member.***” Although it is true that drill guide 84 is capable of being adjusted within transverse slot 82, drill guide 84 **does not** move together with another component about the pivot of yet another member. In fact, Mumme fails to disclose or suggest a cut guide member to begin with. The Mumme device serves as a guide for drilling and placement of condylar pins and does not facilitate any cutting to begin with.

Although Applicants believe the reasons set forth above are sufficient to distinguish the cited prior art, in order to avoid any further delay to issuance of the Application, claim 1 has been amended herein to now also recite that “***the first member is positioned in between the cut guide member and the second member.***” In other words, claim 1 now not only requires that the cut guide member be configured to move together with the second member about the pivot of the first member, but also requires that the cut guide member and second member be

positioned on opposite sides of the first member such that the first member is positioned between the cut guide member and the second member. This added limitation further distinguishes the claimed invention from the cited prior art. Indeed, neither Insall nor Mumme disclose two members which sandwich and move about a pivot of a third member at all, let alone a cut guide member moving about the pivot of a member in between the cut guide member and another component.

### Conclusion

For at least the foregoing reasons, all claims are patentably distinct from the cited prior art. A Notice of Allowance is respectfully requested. Should any further issues remain that would preclude the prompt issuance of a Notice of Allowance, the Examiner is requested to contact the undersigned.

DATED this 6th day of June, 2008.

Respectfully submitted,

Ortho Development Corporation

By /Matthew D. Thayne/  
Matthew D. Thayne  
Registration No. 52,280